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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,808	05/22/2001	Yijun Deng	ORT-1432	1171

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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,808

Applicant(s)

DENG ET AL.

Examiner

Rebecca L Anderson

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-- Th MAILING DATE of this communication app ars on the cov r sheet with th correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 1-3,21 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-3, 21 and 22 are currently pending in the instant application and are objected. Claims 4-20 and 23-30 were cancelled in the amendment filed 5 June 2003.

Information Disclosure Statement

The information disclosure statement filed 23 June 2003 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. The information disclosure statement filed also fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 23 June 2003 was accompanied by a statement that :

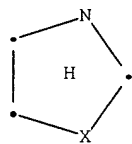
In accordance with 1.97(b), since this information disclosure statement is being filed either within three months of the filing date of the above-identified national application (other than a continued prosecution application under 1.53(d)), within three months of the date of entry into the national stage of the above identified application as set forth in 1.491, or before the mailing date of a first office action on the merits of the above-identified application, or before the mailing date of a first office action after the filing of a request for continued examination under 1.114, not additional fee is required.

However, the filing date of the instant application is 22 May 2001 and a first Office Action on the merits was mailed 24 December 2002. Therefore, the IDS was not filed within three months of the filing date of the national application or before the mailing date of a first office action on the merits.

Election/Restrictions

The subject matter of claims 1-3, 21 and 22 other than that wherein:

X is selected from the group consisting of NH and NR^{A} wherein R^{A} is selected from the group consisting of hydrogen and $-\text{R}$, wherein $-\text{R}$ is aralkyl;



represents a 5 membered aromatic ring structure containing no additional heteroatoms, optionally substituted with one to three substituents independently selected from the group consisting of halogen, hydroxy, alkyl, halogenated alkyl, alkenyl, cycloalkyl, alkoxy, aryl, aralkyl, amino, mono-or di-substituted amino, cyano, nitro, $-\text{COOR}$, $-\text{COR}$, SO_2R and $\text{CONR}^{\text{B}}\text{R}^{\text{C}}$, wherein the amine substituents are independently selected from alkyl, cycloalkyl, aryl or aralkyl, wherein the cycloalkyl or aryl may be further optionally substituted with one or more substituents selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

Z is OR^{A} wherein R^{A} is $-\text{CONR}^{\text{C}}\text{R}^{\text{D}}$;

R³ is selected from the group consisting of hydrogen, alkyl, aralkyl, cycloalkyl, and fluorinated alkyl, wherein the aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

R⁴ is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl, fluorinated alkyl, alkenyl and alkynyl, wherein the alkyl, alkenyl, alkynyl, aryl or aralkyl may be optionally substituted with one or more substituents independently selected from

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halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, aryl, amino, mono-or di-substituted amino, cyano or nitro;

R is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

R^B is independently selected from the group consisting of hydrogen, $-R$, $COOR$, $-COR$, SO_2R , SOR and $-CONR^C R^D$; and

R^C and R^D are independently selected from the group consisting of hydrogen, alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro.

[It is noted that the above generic concept is equivalent to the generic concept as found in the office action mailed 23 December 2002. Although the definition of R_a , R^A is independently selected from hydrogen, $-R$, $-COOR$, COR and $CONR^C R^D$; has been removed from the above generic concept, it does not affect the scope of the identified elected invention (the generic concept) since the values for R_a were already specified in every instance (i.e. the values for R_a are defined in each instance of use as found in the definition of X and the definition of Z .)]

The remaining subject matter of claims 1-3, 21 and 22 that is not drawn to the above elected invention stands withdrawn under 37 CFR 1.142(b), as being for non-elected subject matter, for reasons essentially those given in the last office action. The remaining compounds which are not within the generic concept, which are independent

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and distinct from the generic concept and do not have unity with the species elected and therefore are withdrawn by means of a restriction requirement within the claim are, for example, the compounds wherein:

X is NRa wherein Ra is –COOR, –COR, –CONRcRd and wherein Ra is –R wherein R is alkyl, aryl, cycloalkyl, adamantly, norbornyl, fluorinated alkyl and heterocycle,

The 5-membered ring is substituted with one to three substituents selected from heterocyclyl

Z is ORa wherein RA is hydrogen, –R, –COOR and –COR,

R3 is –COR, –COOR and –CONRcRd,

R is adamantly, norbornyl and heterocycle and

Rc and Rd are heterocycle.

Some examples of specific species that are withdrawn under 37 CFR 1.142(b) as being non-elected subject matter are, for example, Example 28, apge 28 wherein R3 is –COOR and Example 34, page 31, etc.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups which differ from those of the elected invention such as indolyl, imidazolyl, thiazolyl, furyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification

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system, i.e. class 548 subclasses 577(+) (indolyl), class 548 subclasses 300.1(+) (imidazolyl), class 548 subclasses 146(+) (thiazolyl), class 549 subclasses 429 (+) (furyl), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims. The above generic concept does not improperly limit the scope of applicants claims because applicant's claims involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, restriction as has been presented in this application is proper, repeated and the finality is maintained.

Response to Amendment

Applicant's amendment filed 5 June 2003 has been entered and claims 4-20 and 23-30 were cancelled and claims 1, 21 and 22 were amended. Applicant's arguments filed 5 June 2003 have been fully considered but they are not persuasive. Applicant argues that the pending claims have been amended in accordance with the examiner's generic concept indicated to be allowable. However, this argument is not found

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persuasive since the claims still include non-elected subject matter, such as, for example, wherein the 5 membered aromatic ring structure is optionally substituted with heterocyclyl and optionally substituted heterocyclyl, wherein R3 is –COR, COOR and CONRcRd, wherein when X is NRa, Ra is other than hydrogen or –R wherein R is aralkyl, wherein when Z is ORa, Ra is other than CONRcRd and wherein R is selected from adamantyl, norbornyl, heterocycle, etc.

Objections

Claims 1-3, 21 and 22 are objected to as containing non-elected subject matter. Claims 1-3, 21 and 22 presented drawn solely to the elected invention as identified supra would appear allowable over the prior art of record. .

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



Rebecca Anderson
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Art Unit 1626, Group 1620



Joseph McKane
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